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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,640	09/29/2008	Masao Shiozaki	3443-4006	7966
85775      7590      10/05/2010 Locke Lord Bissell & Liddell LLP Attn: IP Docketing Three World Financial Center New York, NY 10281-2101				
			EXAMINER SCHMIDTMANN, BAHAR	
			ART UNIT 1623	PAPER NUMBER
			NOTIFICATION DATE 10/05/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptopatentcommunication@lockelord.com

# Office Action Summary

**Application No.**

10/585,640

**Applicant(s)**

SHIOZAKI ET AL.

**Examiner**

BAHAR SCHMIDTMANN

**Art Unit**

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action details a Restriction Requirement due to a Lack of Unity and One Election of Species Requirements.

#### ***Status of the Claims/Priority***

This application is a 35 U.S.C. § 371 National Stage Filing of International Application No. PCT/JP05/00434, filed 07 January 2005, which claims foreign priority under 35 U.S.C. §119(a-d) to JP 2004-002902, filed 08 January 2004.

#### ***Unity of Invention***

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.

A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression

"specially adapted" does not imply that the product could not also be manufactured by a different process.

As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), the international application shall relate to one invention only or to a group of inventions. Moreover, as stated in PCT Rule 13.2, the requirement of unity of invention referred to in PCT Rule 13.1 shall be fulfilled where a group of inventions is claimed in one and the same international application only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression special technical features shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art, so linked, as to form a general inventive concept.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

When Claims Are Directed to Multiple Categories of Inventions: As provided in 37 CFR 1.475(b), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: (1) A product and a process specially adapted for the manufacture of said product; or (2) A product and process of use of said product; or (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or (4) A process and an apparatus or means

specifically designed for carrying out the said process; or (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process. Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).

### ***Restrictions Requirement***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

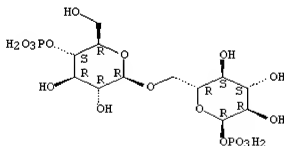
In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claim(s) 1-25, drawn to a compound represented by the general formula (I), wherein W is an oxygen atom or a nitrogen atom
- II. Claim(s) 26, drawn to use of the compound for producing a pharmaceutical composition.
- III. Claim(s) 27, drawn to a method for prophylaxis or treatment of inflammation, which comprises administering a pharmacologically effective dose of the compound according to any one of claims 1 to 19 or a pharmacologically acceptable salt thereof to a warm-blooded animal
- IV. Claim(s) 28, drawn to a method for prophylaxis or treatment of an autoimmune disease, which comprises administering a pharmacologically effective dose of the compound according to any one of claims 1 to 19 or a pharmacologically acceptable salt thereof to a warm-blooded animal.
- V. Claim(s) 29, drawn to a method for prophylaxis or treatment of sepsis, which comprises administering a pharmacologically effective dose of the compound according to any one of claims 1 to 19 or a pharmacologically acceptable salt thereof to a warm-blooded animal.

- VI. Claim(s) 30, drawn to a method for immunosuppression, which comprises administering a pharmacologically effective dose of the compound according to any one of claims 1 to 19 or a pharmacologically acceptable salt thereof to a warm-blooded animal.
- VII. Claim(s) 31, drawn to a method for improving prognosis after coronary artery bypass surgery, which comprises administering a pharmacologically effective dose of the compound according to any one of claims 1 to 19 or a pharmacologically acceptable salt thereof to a warm-blooded animal.

**Examiner's Note:** Claim 26 recites a "use" claim for "use of the compound according to any one of claims 1 to 19 or a pharmacologically acceptable salt thereof for producing a pharmaceutical composition". Claim 26 has been interpreted as drawn to method of making a pharmaceutical composition comprising a compound according to any one of claims 1 to 19.

The technical feature among all groups is a compound of formula (I). The inventions listed as Groups I - VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Homma et al. (*J. Biochem.*, 98, 395-406, 1985, cited by Applicant in Information Disclosure Statement) teaches a compound having the following structure as evidenced by CAPlus (cited in PTO-892).



This structure corresponds to the structure of general formula (I) in claim 1, wherein W and Q is an oxygen atom; R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup> is a hydrogen atom; and R<sup>5</sup> is a hydroxyl.

Consequently, the product lacks a *special technical feature* as defined by PCT Rule 13.2 as it does not possess an inventive step over the teachings of the prior art.

### ***Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the

above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Election of Species***

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

This application contains claims directed to the following patentably distinct compositions comprising a **First** species of compound of general formula (I), see claims 18 and 19 for examples of compounds of general formula (I). Please note, to be fully responsive, Applicant is requested to expressly recite what the variables Q, W, R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup> and R<sup>5</sup> represent.

If Applicant elects the invention of Groups I-VII, Applicant is further required to elect a **First** election of species requirement(s). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).



**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species.**

The election of a species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144.

If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected species, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a). Claim(s) 1 and 20-31 are generic to a compound of general formula (I).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. BAHAR SCHMIDTMANN whose telephone number is 571-270-1326. The examiner can normally be reached on Mon-Thurs 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Shaojia Anna Jiang can be reached on 571-272-0627. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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